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(mas)

SERIAL/PATENT NO. 6,067,451 FILED/ISSUED 5/23/00
APPLICANT Campana Jr et al
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Under 37 CFR § 1.181

5/6/03
DATE

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FILE NO.

David L. Stewart
ATTORNEY

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Rec'd in
OICE on
05-06-03

#14
(mas

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Inter Partes Reexamination)
Requests filed: April 22, 2003 for)
Patent Nos.: 5,436,960, 5,479,472)
5,438,611, 5,625,670, 5,631,946)
5,819,172, and 6,067,451)

PETITION TO COMMISSIONER UNDER 37 C.F.R § 1.181

Mail Stop Petitions,
Commissioner for Patents,
P.O. Box 1450,
Alexandria, Virginia, 22313-1450

Sir:

This is a Petition to the Commissioner under 37 C.F.R. § 1.181 requesting withdrawal of a notice, dated April 22, 2003, in each of the above identified *Inter Partes* Request for Reexaminations, holding that *Inter Partes* Reexamination Requests were improper by virtue section 4608 of the American Inventor's Protection Act which says it applies to "any patent that issues from an original application filed in the United States on or after [the date of enactment-November 29, 1999].

This Petition Requests (1) withdrawal of the notice of April 22, 2003 as improper since jurisdiction is proper, (2) waiver of 37 C.F.R 1.535(g) and 1.560 to permit Requestor to participate in Reexamination under 35 U.S.C. 301-307, (3) that the Patent and Trademark Office order a Director Initiated Reexamination under 35 U.S.C. 313 and (4) deferral of the effective date for an election required by the Notice.

In re Inter Partes Reexamination
Requests filed April 22, 2003

The *Inter Partes* Reexamination Requestor (hereinafter Requestor) in each of the above-identified reexaminations, submits that jurisdiction for the *Inter Partes* Reexamination Request is proper and is found in at least sections 13106 and 13202 of Public Law 107-273 (21st Century Department of Justice Appropriations Authorization Act, hereinafter referred to as the Justice Department Reauthorization Act), which was signed in to law on November 2, 2002 as more fully set forth hereinafter.

I. Section 4608 of the American Inventors Has Been Repealed by Implication

Section 13106 relates to "Appeals in *Inter Partes* Reexamination Proceedings." The section gives the right to third party requesters to appeal any final decision favorable to the patentability of a claim and to be a party to any appeal taken by the patent owner both to the Board of Patent Appeals and Interferences and to the Court of Appeals for the Federal Circuit. That right of appeal is given "with respect to any reexamination proceeding commenced on or after the date of enactment of this act." See section 13106(d).

Similarly, section 13202 of The Justice Department Reauthorization Act authorizes appeals at the Board of Appeals, CAFC, and Civil Action levels and that section "shall apply to any reexamination filed in the United States Patent and Trademark Office on or after the date of enactment of Public Law 106-113 (American Inventor's Protection Act)."

A. Legislative History

The Legislative history of the Justice Department Reauthorization Act and the American Inventor's Protection Act support a conclusion that the Justice Department Reauthorization Act implicitly overruled section 4608 of the American Inventor's Protection Act.

1. Legislative Purpose of Justice Department Act Revisions

At the passage of HR1886, also known as "Providing for Appeals by Third Party in Certain Patent Reexamination Proceedings", by the House of Representatives, Congressman Berman spoke in support of the bill and said the following:

"The bill represents a good, if small, step in improving the usefulness of *Inter Partes* Reexamination procedure for patents. Currently the *Inter Partes* Reexamination procedure places so many constraints on third-party requesters of such reexamination that, as some patent attorneys have stated, "It would be legal malpractice to recommend a client initiate in *Inter Partes* Reexamination [C 147 Cong Rec H 5359 September 5, 2001].

CONFIDENTIAL

2 History of the American Inventors Protection Act

a. Purpose to Reduce Federal Court Litigation

When Senator Hatch and Senator Layne introduced the American Inventor's Protection Act of 1999, Senator Hatch said the following:

"6th, the bill designed to reduce litigation in district courts and make reexamination a viable, less-costly alternative to patent litigation by giving third-party requesters the option of Inter Partes Reexamination procedures. [C 145 Cong Rec S 13258.

b. Congress Did Not Substantively Consider Section 4608

Prior to passage of the American Inventor's Protection Act of 1999, Congresswoman Mink said the following:

"Along with these concerns, I object to the speed, secrecy and convoluted method by which this bill has been slipped on to the floor late at night under suspension of the rules.... I find the manner in which this bill was brought to the House floor unacceptable.... Far from a lengthy informed process, H.R. 1907 makes its way to this chamber following a slippery, silent path which featured name changes, number changes, unpublished documents, and finally this evening an unpublished bill, finished only minutes before called up for

approval...if it is a wonderful piece of Legislation and protects the rights of the small inventor why is it not open to more than the minimum debate and why can't we hold hearings on this final version whose ink is not yet dry?

The judiciary committee marked up H.R. 1907 without the benefit of hearings; providing no public forum for the stakeholders involved. This stark omission comes in spite of extensive controversy surrounding this issue in 105th congress. There is no published report on HR 1907 and until this evening, this House was scheduled to consider a patent bill almost half the length of HR 1907. I was expecting to debate HR 2654, and was shocked to find that HR 1907 was resurrected and had usurped its place. This is an appalling way to manage Legislation embodying such an expansive scope and consequences." [C 145 Cong Rec E 1756 {August 5, 1999}]

When addressing Title V—the Patent Litigation Reduction Act, Congressman Howard Coble states:

"Generally. [sic] Title V is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing ex parte reexamination in Chapter 30 of title 35, the option of inter partes reexamination proceedings in the PTO. Congress enacted legislation to authorize ex parte reexamination of patents in the PTO in 1980 but such reexamination has been used infrequently since a third-party who request reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the PTO. Title V

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provides an opportunity as an option to the existing ex parte reexamination procedures." [145 Cond Rec E 1788]

Congresswoman Kaptur urged a no vote on the American Inventor's Protection Act of 1999 stating as follows:

"Mr. Speaker, We urge members to vote no this morning on HR1907, the so-called American Inventor's Protection Act of 1999. This bill is being brought up under suspension. It should be brought up under regular order. It is a very consequential bill. Last night the bill was brought on this floor at 9:17PM as the last item of business. Those who have concerns about the bill and did not even have a chance to read it were limited to ten minutes on a bill with constitutional consequences.

"This is not the bill that cleared the committee on the Judiciary on May 26, 1999. I think our U.S. Patent system deserves more than this cursory treatment by the leadership of this institution." [145 Cong Rec H 6970]

c. Immediately Prior to Late Night Passage

It is significant that section 4608 of the American Inventor's Protection Act, as of November 17, 1999, immediately prior to the vote passing the American Inventor's Protection Act, read as follows:

SEC.4608. EFFECTIVE DATE.

(a) in general. - subject to subsection (b), this subtitle in the amendments made by this subtitle shall take effect on the date of the enactment of this act and shall apply to any patent that issues from an original application filed in the United States on or after that date.

(b) section 4605 (a). - the amendments made by section 4605 (a) shall take effect on the date that is one year after that date of the enactment of this act. [145 Cong Rec H 12586]

There were no date restrictions as to when a patent issued. Thus it is clear that section 4608 was changed in a significant way with no publication, with no significant consideration by members of Congress, and with no indication of awareness on the part of anyone, other than the unknown person(s) who inserted the language, as to the changes.

It is significant that section 4608 was not codified as part of Title 35.

It is reasonable to assume that the members of Congress were not aware specifically of the changes to Section 4608 that occurred between the previous version and the version that was presented to them on a vote late at night when the American Inventors Protection Act was passed.

In fact, when the Justice Department Reauthorization Act was considered, since 4608 was not part of Title 35, it is not likely that Congress was anymore aware at the time of the passage in the Justice Department Reauthorization Act, that there were any limitations on the Inter Partes Reexamination practice by virtue of the date on which a patent issued. As a result, Congress granted, in sections 13106 and 13201 of the Justice Department Reauthorization Act a plenary right of appeal to any third-party Inter Partes Reexamination requestor apparently under the assumption that participation rights were a given. As a result, as a third-party Inter Partes Reexamination

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requestor, Requestor is entitled to a right of appeal of a decision on the reexamination.

d. Right of Appeal Implies a Right of Participation

The right to appeal implies the right to participate in development of issues that would not otherwise be fully developed. To impose participation limits on a reexamination requestor when he has not been in a position to make sure that the issues are fully developed for appeal it is unwarranted and unfair.

Rather, the conclusion must be drawn from this history is that Congress, in passing the Justice Department Reauthorization Act, implicitly overruled Section 4608 which was never codified.

The holding by the Patents Special Projects Advisor of the office of Patent Legal Administration that requestor is not entitled to Inter Partes Reexamination by virtue of section 4608 is improper and incorrect.

Accordingly, requestor request that the commissioner withdraw the notice dated April 22, 2003 and allow the Inter Partes Reexamination to proceed.

II. Alternative Relief--Reexamination Under 35 USC 301 et seq. with Participation

The difference between Ex Parte and Inter Partes Reexamination lies mainly in the ability of the requestor to participate in the examination proceedings.

1. The requirement that "Ex Parte" reexamination be "Ex Parte" is not statutory.

Reexamination files are open to the public. See 37 C.F.R. 1.11. Therefor it is possible to have reexamination under 35 U.S.C. 301-307 in which an interested party can submit comments on each action issued by the Examiner and on each response filed by the applicant. (The office already sends copies of Office Actions to Ex Parte requestors.)

The only prohibition to such a practice might be found in 37 C.F.R. 1.535 (g) and 1.560.

Therefore, it is possible for "Ex Parte" reexamination under 35 U.S.C. 301-307 to proceed with Requestor participation by waving 37 C.F.R. 1.535 (g) and 1.560.

2. Conditional Election

Accordingly, if the Inter Partes Request for Reexamination of eight NTP patents is not granted, applicants elect to convert those Inter Partes Reexamination requests to ex parte requests, provided that the provisions of 37 C.F.R. 1.535 (g) and 1.560 are waived to permit requestor participation.

3. Request for waiver of 37 C.F.R. 1.535 (g) and 1.560 under 37 C.F.R. 1.183

Requestor respectfully requests waiver of 37 C.F.R. 1.535 (g) and 1.560 under 37 C.F.R. 1.183. The request is appropriate for the following reasons:

a. Extraordinary situation:

The Patent and Trademark Office issued 1,690 claims with essentially no prosecution on the merits. This in itself constitutes an extraordinary situation. Second, there is a need to give integrated consideration of all NTP patents during reexamination. Third, 47 companies were targeted by NTP on these patents. Thus, all of the patents should be treated together. Finally, there is an extended chain of continuing applications which are related by terminal disclaimers which require that claims, that are not patentably distinct, be treated together. All of these factors indicate the presence of an extraordinary situation.

b. When Justice Requires

The director has already ordered reexamination of six of eight NTP patents (five director initiated and one ex parte). The other two NTP patents should be considered to provide complete protection to the public from potentially invalid claims. Finally, justice requires waving the rules because the best development of the issues will result if interested third parties can assist the Examiner in evaluating extremely complex and numerous issues.

Accordingly, the conditions for waiver of the rules under 37. C.F.R. 1.183 have been met.

III. Reasons to Allow Inter Partes Reexamination

A. Claims to Related Patents Are Not Patentably Distinct

There are other reasons why the notices should be with drawn and the Inter Partes Reexamination be allowed to proceed. The entire set of eight patents which are subject to the reexamination request originated with three original substantially identical patent disclosures. Subsequent to those original three applications, one divisional was filed and a plurality of continuations, having related but different claims, were filed. The claims of all eight patents are not patentably distinct in the opinion of the undersigned. This was explicitly recognized with the requirement for terminal disclaimers in some cases, namely in U.S. Patents 6,317,592, 6,067,451, 5,819,172 and 5,625,670 and 5,436,960. Nevertheless, it is implicit in others. It is the case that even though there are some differences, the differences do not rise to the level of being patentably distinct.

If the Patent and Trademark Office were to exclude reexamination of all but the last issued patent, it would not allow the Patent and Trademark Office to give complete relief. Rather, contrary to congressional intent, federal court litigation would be multiplied, rather than reduced. The eight NTP patents were the subject to notices to some forty-seven companies which were targeted by NTP's licensing campaign. This created the possibility of forty-seven separate lawsuits versus one reexamination procedure within the Patent and Trademark Office.

Thus, allowing Inter Partes Reexamination would further the congressional intent by reducing federal court litigation.

**B. Allowing Inter Partes Reexamination Would
Facilitate Handling of Existing Director
Initiated Reexaminations.**

There is another reason why the Patent and Trademark Office should allow the Inter Partes Reexaminations to proceed. First, the director of the Patent and Trademark Office has already ordered director-initiated reexamination of five of the NTP patents. Subsequently, the Patent and Trademark Office has ordered reexamination of a sixth patent. Only two of the eight NTP patents are new. If the Patent office chooses not to allow participation by the requestor in the reexaminations of the eight NTP patents, the Examiner will need to evaluate seven different references and apply them to 1,921 claims. The requestor has done that work with a team of attorneys and the Examiner can obtain the benefit of that work without having to duplicate it. If desired, that work product can be provided electronically which would vastly shorten the Examiners time required to analyze the patents and references and shorten the time to prepare an Office action. Further, if the Patent and Trademark Office were to merge the five directors initiated reexaminations, the one Ex Parte Reexamination already ordered, with the eight Inter Partes Reexaminations requested, the result would be a substantial increase in efficiency and greater dispatch in resolving all reexamination proceedings.

C. The Argument from Equity

There is yet another argument that the Patent and Trademark Office should allow the Inter Partes Reexaminations to proceed. The Patent Office, through a lapse in normal reexamination procedures, allowed 1,690 claims of the 1,921 claims without any substantive examination on the merits. This has caused great disruption in the industry. By allowing the Inter Partes Reexaminations to proceed, the Patent Office is in a position to essentially fix the problems which resulted from any lackluster examination of the original patents.

D. Benefits to the Patent and Trademark Office

There are several benefits to the Patent and Trademark Office from allowing the Inter Partes Reexaminations requested to proceed.

1. Consistency with Title 35 United States Code

First, allowing Inter Partes Reexamination to go forward would permit an integration of the reexamination practice with Title 35 of the United States Code. This will do away with the aberration of having an unmodified section of the American Inventor's Protection Act from creating technical difficulties with the reexamination practice. Remember that section 4608 was not codified in Title 35.

2. Allow the Patent and Trademark Office to Give Complete Relief

Next it permits the Patent and Trademark Office to resolve all issues relating to an invention even though the invention is claimed in different patent applications.

It allows the Patent and Trademark office to correct errors in related patents and thus present a unified posture to the public.

3. Patent & Trademark Office Expertise

Further, it is socially useful to have the Patent and Trademark Office resolve validity issues in which it has particular expertise, while leaving infringement issues to the courts.

4. International Harmonization

Interpreting the Justice Department Reauthorization Act is suggested herein would result in a harmonized practice with other nations. Other industrialized nations permit nullity actions to be prosecuted separately from infringement actions.

5. Economy of Effort

Finally, there is an economy of examining effort to be achieved by allowing the reexaminations to go forward. Allowing them to go forward would permit an Examiner to decide between two positions developed by different legal parties versus having to develop the issue themselves at great duplication of effort.

**IV. Alternative Relief-Director Initiated Inter Partes
Reexamination**

If neither of the previous requests for relief are granted, Requestor specifically requests that the Director of the Patent and Trademark Office initiate Inter Partes Reexamination under 35 U.S.C. 313 and allow Requestor to participate.

V. Request for Deferral of Effective Date for Election

The Patents Special Projects Advisor indicated that Requestor must elect whether to pursue Inter Partes Reexamination or elect to convert the Inter Partes Request to an Ex Parte Request by the due date. Since that election cannot be reasonably be made without knowing the outcome of Patent and Trademark Office consideration of this petition and since Requestor has made a contingent election, Requestor requests that the requirement of the Patents Special Projects Advisor be held in abeyance until decision on this Petition is received by Requestor.

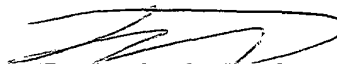
VI. Conclusion

For the reasons indicated, Requestor requests that they be allowed to participate in the reexamination of all eight NTP patents either (1) under the Inter Partes Reexamination procedures or (2) under the "ex parte" reexamination procedure expanded by waiver of 37 C.F.R. 1.535 (g) and 1.560 or (3) by participation in a Director

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initiated Inter Partes Reexamination under 35
U.S.C. 313.

Respectfully Submitted,



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